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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/662,531

09/15/2000

Kannan Varadhan

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LUCENT TECHNOLOGIES INC.

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HOLMDEL, NJ 07733

EXAMINER

STEVENS, ROBERTA A

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/662,531

Applicant(s)

VARADHAN ET AL.

Examiner

Roberta A Stevens

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (U.S. 6587882) in view of Bhagwat (U.S. 6651105).

4. Regarding claim 1, Inoue teaches (figure 1) a method for configuring a portable and/or mobile host that powers up in a foreign network to connect to the internet, comprising: using the M-IP protocol to contact the M-IP home agent and request the bootstrapping agent to allocate the temporary home address to the host:

5. Inoue does not teach creating a bootstrapping agent that works cooperatively with a M-IP home agent to allocate a temporary home address to the host; and using the temporary home

Art Unit: 2665

address to create a temporary tunnel between a foreign agent associated with the host and the M-IP home agent, wherein the temporary tunnel is used to communicate configuration information including a permanent home address allocated by the DHCP protocol for the host to connect to the internet.

6. Bhagwat teaches (col. 2, lines 38-56) creating a bootstrapping agent that works cooperatively with a M-IP home agent to allocate a temporary home address to the host; and using the temporary home address to create a temporary tunnel between a foreign agent associated with the host and the M-IP home agent, wherein the temporary tunnel is used to communicate configuration information including a permanent home address allocated by the DHCP protocol for the host to connect to the internet. It would have been obvious to one of ordinary skill in the art to adapt to Inoue's system Bhagwat's concept of using a temporary IP address when a mobile is roaming so that the packets destined for the mobile are directly sent to the foreign agent instead eliminating them being forwarded by the home agent.

7. Regarding claim 2, Inoue teaches (figure 1) the foreign agent is co-located with the host.

8. Regarding claim 3, Inoue teaches (figure 1) the foreign agent is located on a device that is external to the host and resides in the foreign network

9. Regarding claim 4, Inoue (figure 6) teaches the bootstrapping agent is arranged to assign IP addresses from an address pool of private addresses.

Art Unit: 2665

10. Regarding claim 5, as for the private address taking the form 10*, this is a well known format of address in private network's and It would have been obvious to one of ordinary skill in the art to adapt to Inoue and Bhagwat's system as it is well known in the art.

11. Regarding claim 6, Inoue (figure 6) the bootstrapping agent is arranged to assign IP addresses from an address pool of public address.

12. Regarding claim 7, Bhagwat teaches (col. 2) a DHCP client located on the host is used to generate messages requesting the configuration information from a DHCP server via the temporary tunnel.

13. Regarding claim 8, Bhagwat teaches (col. 2) the messages generated by the DHCP client are modified at the host to have a format consistent with a DHCP relay.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 9-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Bhagwat.

Art Unit: 2665

16. Regarding claim 9, Bhagwat teaches (col. 2 and figures 5-6) a method for enabling a mobile host without an IP home agent to connect to the internet when powering up in a foreign network, comprising: obtaining a temporary IP home address for the host from an IP address source accessible through a mobile IP home agent; establishing a transient tunnel between the mobile IP home agent and a mobile foreign agent associated with the mobile host while the foreign network, using the temporary IP home address; acquiring via the transient tunnel, configuration parameters including a permanent IP home address from a DHCP server in the home network of the host; replacing the transient tunnel with a new tunnel between the mobile IP home agent and the mobile IP foreign agent using the permanent IP home address.

17. Regarding claim 10, Bhagwat teaches (col. 2 and figures 5-6) a method for enabling configuration of a portable host device that powers up in a foreign network to communicate using the internet, comprising: communicating a temporary home address to the host from bootstrapping agent operating cooperatively with a mobile IP home agent that serves the host device when it operates in the foreign network; establishing a transient bi-directional link between the ht and the mobile IP home agent using the M-IP protocol and the temporary home address; and obtaining a permanent address from a DHCP server via the transient bi-directional communication link, wherein the permanent address use thereafter to configure the host to communicate with the internet.

18. Regarding claim 11, Bhagwat teaches (cols. 7-8) additional configuration parameters are provided to the portable host via the transient bi-directional communication link.

Art Unit: 2665

19. Regarding claim 12, Bhagwat teaches (col. 2 and figures 5-6) a method for configuring a mobile host when it powers up in a foreign network, comprising: using a M-IP protocol in the host as the signaling mechanism for reaching the home network and dynamically allocating a temporary home address; and thereafter using DHCP with the temporary home address to allocate a permanent home address and other configuration state for the host.

20. Regarding claim 13, Bhagwat teaches (col. 2 and figures 5-6) a method for configuring a mobile host that powers up in a foreign network, comprising: setting up a temporary IP tunnel via the M-IP protocol to connect the mobile host to its home network; using an IP broadcasting protocol over the temporary IP tunnel so that the host can discover a DHCP addressing server in its home network; and using the DHCP protocol to communicate addressing and configuration information between the addressing server and the host.

21. Regarding claim 14, Bhagwat teaches (col. 2 and figures 5-6) a method for configuring the mobile host when it powers up in a foreign network without an IP home agent address, comprising: obtaining a temporary IP home address for the host from an IP address source accessible through the home server; establishing a transient tunnel between the mobile IP home server and a mobile foreign server using the temporary IP home address; acquiring via the transient tunnel, permanent configuration parameters including a permanent IP home address from a DHCP server in the region served by the home server; replacing the transient tunnel with a new tunnel between the home server and the foreign server using the permanent IP home address.

Response to Arguments

22. In response to applicant's arguments, the recitation "a method for configuring a portable and/or mobile host that powers up in a foreign network to connect to the internet" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

23. Applicant argues that Bhagwat does not teach the temporary home address, because a mobile host that powers up in a foreign network with no home address cannot contact addressing servers in it's home network. Applicant is directed to the above paragraph which responds to the preamble where powering up in a foreign network is addressed. Also as mentioned above, as recited in col. 2, lines 39-56, Bhagwat does teach a temporary address obtained by DHCP.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 2665

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

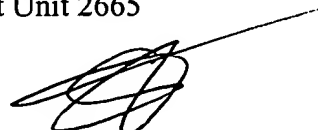
26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberta A Stevens whose telephone number is 571-272-3161.

The examiner can normally be reached on M-F 9:00am-5:30pm.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Roberta A Stevens
Examiner
Art Unit 2665



STEVEN NGUYEN
PRIMARY EXAMINER